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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/740,257	12/18/2003	Rainer Kuth	P03,0571	1901

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EXAMINER

DAYE, CHELCIE L

ART UNIT PAPER NUMBER

2161

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/740,257	Applicant(s) KUTH ET AL.	
	Examiner Chelcie Daye	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/26/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is issued in response to Application filed December 18, 2003.
2. Claims 1-10 are pending.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on 5/26/04 was filed after the mailing date of the application. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter "a plurality of medical dictionaries", which was not described in the specification in such a way as to

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enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The limitation of claim 5 discloses, "said memory containing a plurality of dictionaries". Examiner is unclear as to what types of dictionaries are provided and what the significance is for having multiple dictionaries wherein each contains respectively different languages. Dictionaries do not necessarily have to solely be written in one language, some dictionaries are represented with various languages written throughout, in order to allow less clutter and less occupancy of space. In order to further prosecution, examiner will give the claim its broadest reasonable interpretation.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by**

Vining (US Patent No. 6,785,410) issued August 31, 2004.

Regarding Claim 1, Vining discloses a device for standardized and digitized generation of medical findings comprising:

a databank in which a plurality of anatomical localization images are stored and in which evaluation parameters respectively associated with the anatomical localization images are stored (column 8, lines 22-52, Vining) sorted hierarchically and according to the respective anatomical localizations in the anatomical localization images (column 12, lines 19-39, Vining);

a display monitor (Fig.2, item 28, Vining);

an evaluation system having access to said databank and connected to said display monitor (column 4, lines 16-38, Vining);

an input unit connected to said evaluation system (Fig.2, item 27; column 4, lines 5-15, Vining); and

said evaluation system being supplied with a clinical image of anatomy of a subject (columns 12-13, lines 62-67 and 1-6, respectively, Vining) and automatically retrieving one of said anatomical localization images from said databank corresponding to said anatomy in said clinical image (column 4, lines 16-26, Vining) and automatically displaying one of said anatomical localization images on said display monitor together with text representing a medical finding in a standardized form appropriate for said anatomy in said clinical image, dependent on said evaluation parameters and dependent on information specific to said subject entered into said evaluation system via said input unit (Figs.7b & 7c; column 8, lines 53-67 and column 15, lines 22-42, Vining).

Regarding Claim 2, Vining discloses a device wherein said databank contains data representing said anatomical localization images as modules respectively representing different body parts (Fig. 9B & 9C, Vining).

Regarding Claim 3, Vining discloses a device comprising a user-operable graphical interface allowing a user to interact with said one of said anatomical localization images on said display monitor to make a designation in said one of said anatomical localization images on said display monitor, and wherein said evaluation unit uses said designation to generate said medical finding in said standardized form (column 12, lines 30-48, Vining).

Regarding Claim 4, Vining discloses a device further comprising a memory accessible by said evaluation system (column 4, lines 39-56, Vining) containing at least one medical dictionary containing data representing text for medical terms (column 5, lines 4-13, Vining), and wherein said evaluation unit generates said medical finding in said standardized form using said medical terms in said medical dictionary (column 9, lines 52-67, Vining).

Regarding Claim 5, Vining discloses a device wherein said memory contains a plurality of medical dictionaries in respectively different languages, and wherein said input unit allows a user to select one of said languages

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(columns 17-18, lines 63-67 and 1-9, respectively, Vining), and wherein said evaluation unit automatically generates said medical finding in said standardized form using medical terms in said selected language (column 13, lines 54-56, Vining).

Regarding Claim 6, Vining discloses a device wherein said evaluation unit automatically generates a physician's report, as an evaluation of said clinical image, embodying said medical finding in said standardized form using said medical terms in said selected language (column 13, lines 41-56, Vining).

Regarding Claim 7, Vining discloses a device comprising a memory accessible by said evaluation system in which previous medical findings for said subject generated by said evaluation system are stored (column 8, lines 3-21, Vining), and wherein said input unit allows a user to retrieve at least one of said previous medical findings from said memory for comparison with a current medical finding generated by said evaluation system for said subject (column 7-8, lines 60-67 and 1-2, respectively, Vining).

Regarding Claim 8, Vining discloses a device wherein said evaluation system automatically generates a delta report identifying differences between said current medical finding and said at least one of said previous medical findings (column 8, lines 3-21, Vining).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vining (US Patent No. 6,785,410) filed November 21, 2001, in view of Harnsberger (US Patent Application No. 20040107118) filed November 26, 2003; provisional date November 27, 2002.

Regarding Claim 9, Vining discloses a device wherein said input unit allows a practitioner to enter data for generating a physician's report embodying said medical finding in said standardized form (columns 13-14, lines 66-67 and 1-11, respectively, Vining). However, Vining is silent with respect to said evaluation system contains stored, standardized guidelines and wherein said evaluation system compares said data to said standardized guidelines. On the other hand, Harnsberger discloses said evaluation system contains stored, standardized guidelines ([0073], lines 1-8, Harnsberger) and wherein said evaluation system compares said data to said standardized guidelines ([0094], lines 1-24, Harnsberger). Vining and Harnsberger are analogous art because they are from the same field of endeavor of allowing easy access to reference information

regarding medical education. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Harnsberger's teachings into the Vining system. A skilled artisan would have been motivated to combine as suggested by Harnsberger at [0026], lines 1-28, in order to create medical annotations and attach these annotations about any diagnosis provided in the library to medical images. As a result developing a system for gathering, storing, and distributing valuable information and knowledge.

Regarding Claim 10, the combination of Vining in view of Harnsberger, disclose a device further comprising an accounting system connected to said evaluation system for generating an invoice for evaluation of said clinical image (column 13, lines 57-65, Vining), and wherein said evaluation system allows said invoice to be generated only if said data in said physician's report conforms to said standardized guidelines (columns 3-4, lines 61-67 and 1-3, respectively, Vining).

Points of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chelcie Daye whose telephone number is 571-272-3891. The examiner can normally be reached on M-F, 7:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chelcie Daye
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June 20, 2006


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